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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/633,563

08/05/2003

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EXAMINER

LIN, WEN TAI

ART UNIT

PAPER NUMBER

2154

MAIL DATE

DELIVERY MODE

01/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/633,563	Applicant(s) EGUCHI ET AL.	
	Examiner Wen-Tai Lin	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-24 are presented for examination.
2. The text of those sections of Title 35, USC code not included in this action can be found in the prior Office Action.

Claim Rejections - 35 USC § 102

3. Claims 1-3, 10, 14-18, 21 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Mori et al.[U.S. PGPub 20010013056].
4. As to claim 1, Mori teaches the invention as claimed including: an electronic mail server device [e.g., Figs. 2 and 7] comprising:
 - means for receiving an electronic mail [e.g., S701-S702, Fig.7];
 - means for determining whether a prescribed processing condition is satisfied in accordance with the received electronic mail [e.g., S703, Fig.7], wherein the means for determining determines whether a prescribed processing condition is satisfied based on a condition of a transmitting side of the electronic mail and a condition of a receiving side of the electronic mail [i.e., inherently the prescribed processing condition on the transmitting side is that the size of the email is larger than a threshold, while the

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receiving side condition is that the size of the received email must not exceed the threshold]; and

means for controlling to execute a prescribed processing to the received electronic mail when the processing condition is satisfied [e.g., S704-S711, Fig. 7].

5. As to claim 2, Mori further teaches that the prescribed processing condition is when a size of the received electronic mail or an attached file exceeds a prescribed value, and when the size of the received electronic mail or the attached file exceeds the prescribed value [Abstract], the means for controlling executes the following processing:
(a) dividing and forwarding the electronic mail [e.g., Fig.7];

6. As to claim 3, Mori further teaches that the prescribed value of the size of the electronic mail or the attached file is a value specific to each electronic mail address or each domain of a destination of the electronic mail [e.g., S702, Fig.7; i.e., the upper limit value is specific to the destination address].

7. As to claim 10, Mori further teaches that the prescribed processing condition is when specific data is included in the received electronic mail [i.e., the mail dividing information], and when the specific data is included in the received electronic mail, the means for controlling executes the following processing:

(a) removing the specific data from the electronic mail and forwarding the electronic mail [e.g., paragraphs 88 -112; Figs. 9-10; i.e., the mail dividing information is removed after the divided mail pieces are put together as its original mail];

8. As to claim 14, Mori further teaches that the prescribed processing condition is when receiving a plurality of divided electronic mails, and when receiving the plurality of divided electronic mails, the means for controlling restores the received plurality of divided electronic mails into one electronic mail, and forward the electronic mail [Figs. 8-10].

9. As to claim 15, Mori further teaches that the means for controlling receives data which defines the processing condition and processing corresponding to the processing condition from a remote device under a prescribed communication protocol [e.g., paragraph 10; i.e., the content of preference information is entered by remote subscribers].

10. As to claims 16-18, 21 and 24, since the features of these claims can also be found in claims 1-2, 10 and 14, they are rejected for the same reasons set forth in the rejection of claims 1-2, 10 and 14 above.

11. Claims 1, 4-9 and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Balma et al.[U.S. Pat. No. 6157945].

12. As to claims 1, 4 and 6, Balma teaches the invention as claimed including: an electronic mail server device comprising:

means for receiving an electronic mail [e.g., Fig. 1; Abstract];

means for determining whether a prescribed processing condition is satisfied in accordance with the received electronic mail [e.g., Figs. 13-14], wherein the means for determining determines whether a prescribed processing condition is satisfied based on a condition of a transmitting side of the electronic mail and a condition of a receiving side of the electronic mail [e.g., inherently the prescribed processing condition on the transmitting side is that it is able to convert an electronic mail to a facsimile format and the receiving side condition is that a receiver application is able to receive the converted facsimile message]; and

means for controlling to execute a prescribed processing to the received electronic mail when the processing condition is satisfied [e.g., Fig. 17].

Balma further teaches that the prescribed processing condition is when an attached file of the received electronic mail is a specific format, and when the attached file of the received electronic mail is the specific format [e.g., col.1, lines 9-13; Fig. 5], the means for controlling executes the following processing:

(a) converting the attached file into a prescribed format and forwarding [e.g., col. 8, lines 16-33; col.4, lines 51-61; col.5, lines 65-67; col. 8, line 61- col. 9, line 10];

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13. As to claims 5 and 7, Balma further teaches that the specific format is a format which is specific to each electronic mail address or each domain of a destination of the electronic mail [i.e., the target format is selected by each recipient using database fields of Fig.5].

14. As to claims 8-9 and 19-20, since the features of these claims can also be found in claims 4 and 6-7, they are rejected for the same reasons set forth in the rejection of claims 4 and 6-7 above.

15. Claims 1, 11-12 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Katsikas [U.S. PGPub 20050188045].

16. As to claims 1, 11, Katsikas teaches the invention as claimed including: an electronic mail server device comprising:

means for receiving an electronic mail

means for determining whether a prescribed processing condition is satisfied in accordance with the received electronic mail, wherein the means for determining determines whether a prescribed processing condition is satisfied based on a condition of a transmitting side of the electronic mail and a condition of a receiving side of the electronic mail [i.e., inherently a condition for the prescribed processing (e.g., SPAM filtering on a mail server) is that the transmitting side's sender address is contained in the ASL list and the receiving side (client) has logged on to the mail server]; and means

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for controlling to execute a prescribed processing to the received electronic mail when the processing condition is satisfied [e.g., Fig. 1B and 4B].

Katsikas further teaches that the prescribed processing condition is when a transmitter terminal of the received electronic mail is a specific address or a specific domain, and when the transmitter terminal of the received electronic mail is the specific address or the specific domain, the means for controlling executes the following processing: (a) forwarding the electronic mail to a prescribed destination [e.g., 211, Fig.4B];

17. As to claim 12, Katsikas further teaches that the prescribed processing condition is when a transmitter terminal of the received electronic mail is neither a specific address nor a specific domain, and when the transmitter terminal of the received electronic mail is neither the specific address nor the specific domain, the means for controlling executes the following processing:

(a) forwarding the electronic mail to a prescribed destination [e.g., paragraphs 25 and 34-35];

18. As to claim 22, since the features of this claim can also be found in claims 11, it is rejected for the same reasons set forth in the rejection of claims 11 above.

Claim Rejections - 35 USC § 103

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19. Claims 13 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al.(hereafter "Mori")[U.S. PGPub 20010013056], as applied to claims 1-3, 10, 14-18, 21 and 24 above, further in view of Official Notice.

20. As to claims 13 and 23, Mori does not specifically teach what to do when failing to forward the received electronic mail.

However, Official Notice is taken that it is well known fail-to-delivered emails are normally returned to their respective senders.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to return a fail-to-delivered email back to its sender because it alerts the sender of the failure such that new delivery method may be attempted.

21. Applicant's arguments filed on 11/19/07 for claims 1-24 have been fully considered but they are not deemed to be persuasive. Specifically, Applicant argues in the remarks that: (1) in rejecting the independent claims the passages recited from the prior art (e.g., Mori, Balma and Katsikas) only describe conditions on the transmitting side for the prescribed processing. None of the prior art requires conditions on both the transmitting side and conditions on the receiving side for the prescribed processing and (2) the passages recited from Balma in the rejection of claims 4-7 do not teach that the attachment is (or not) a specific format etc.

22. Examiner respectfully disagrees with applicant's remarks.

As to point (1), it is noted that the claim languages are not specific about the content of the prescribed processing and the conditions set forth upon the transmitting and receiving sides. It is therefore generally interpreted as a transmitting condition that enables or triggers the prescribed processing and a receiving condition that enables or associates with the processed outcome to be delivered to the receiving side. For example, In Mori reference a transmitting condition for the prescribed processing (i.e., partitioning a large file) is that the transmitting side sends out a file larger than a designated threshold and that the partitioned file must be acceptable to the receiving end, meaning that the condition on the receiving side is that a received file size must be less than the specified threshold. In other words, the partitioning process does not blindly partition any file into an arbitrary file size; it must satisfies a criterion (e.g., a threshold) derived from the receiving side and use the transmitting conditions that (a) the file is being sent to a destination where a limit to the file size exists and (b) the transmitted file size is indeed larger than a threshold associated with the receiving end. See paragraphs 12 and 16 of the instant office action for similar argument in the rejection of claim 1 citing Balma and Katsikas as prior art.

As to point (2), Applicant is directed to col.7, lines 54-58 of Balma reference, wherein the database has a field specifying communication preferences of the recipient. In other words, the specified formats in Fig.5 are preferred formats to be sent to the receiving end. This includes the email attachment. Furthermore, by associating very low preference values with certain type of formats in Fig. 5, it is equivalent to suggest not using those specific formats for communication.

For at least the above reasons, it is submitted that the prior art of record reads on the claims.

23. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

24. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Examiner note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part

of the claimed invention, as well as the contest of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday(8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:


(571) 273-8300 for official communications; and

(571) 273-3969 for status inquires draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

January 25, 2008


1/25/08